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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,512	02/06/2002	Louise C. Sengupta	PARA 50243	1051

27512 7590 05/21/2003

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EXAMINER

LEE, BENNY T

ART UNIT	PAPER NUMBER
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2817

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	7

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 20 Feb 2003 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire Three (3) month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-9 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-9 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are: ☐ acceptable;
☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

SN 68512

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The disclosure is objected to because of the following informalities: Page 1, lines 1-4, note that the patent status information for parent application S.N. 419047 should be moved from it's present location to a location following the filing date of the present application to avoid potential confusion in that the patent information relates to the provisional application which immediately preceding the patent information. Appropriate correction is required.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, note that the recitation that the "second layer" has a "dielectric constant less than 30" does not appear to have been explicitly disclosed in the original specification, and thus must be treated as "new matter". Moreover, the "first and second ground planes" being "on opposite ends of said conductor" does not appear to have been supported by the original specification and thus must be treated as "new matter".

However, if applicants' disagree that the above cited limitation is not "new matter", then an appropriate explanation is required, including pointing out where explicit support for this limitation can be found in the original specification.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1, note that it is unclear whether a "coplanar line" is properly characterized^{by} the invention, as recited. Note in particular that the body of claim 1 appears to define "a first layer, of a multi-layered stack ..." and "a second layer, of a multi-layered stack ...", which appears to define the waveguide of Fig. 10. Furthermore, the coplanar waveguide arrangement of Fig. 9 can not be consistent with the "multi-layered stack" which defines the waveguide as depicted in Fig. 10. Clarification is needed.

In claim 1, note that for the "first" & "second" layers, it is unclear how each recitation of "a multi-layered stack" relates to each other (i.e. the same "stack", different "stacks", etc). Similarly, it is unclear how each recitation of "a dielectric constant" relates to each other (i.e. same, different, etc). For each instance noted above should the second occurrence of the limitation be --the-- instead of "a"? Furthermore, note that it is unclear whether "at least one of said first and second electrodes" can be properly characterized as being "positioned between the first and second layers" (i.e. is it proper to have both the first and second electrodes disposed between the first and second layers?). Clarification is needed.

The following claims have been found objectionable for reasons set forth below:

In claim 3, note that the non-positive recitation "can" should be deleted as being unnecessary.

In claims 6, 9, note that the numerical symbols in each chemical composition should be placed in a subscripted format.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 ^FCAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 ^FCAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 ^FCAR 3.73(b).

Claims 1-3, 5, 6, 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7 of co-pending Application No. 68355. Although the conflicting claims are not identical, they are not patentably distinct from each other because aside from the specific apparatus recited in the preamble of the claims of each application, the remaining structural and functional limitations are otherwise identical.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

It should be noted that the terminal disclaimer filed 20 February 2003 has been accepted. In that terminal disclaimer, applicants' appear to have voluntarily disclaimed this over the parent U. S. Patent No. 6377142. While such is disclaimer is proper, it has no affect on the above obviousness double patenting rejection with respect to co-pending application Serial No. 68355, and thus that is why the double patenting rejection is sustained. Note that to overcome the above obviousness double patenting rejection, applicants' must explicitly terminally disclaim over the co-pending application.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 ^FCAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 ^FCAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benny Lee whose telephone number is (703) 308 4902.

A handwritten signature in cursive script that reads "Benny Lee".

BENNY T. LEE
PRIMARY EXAMINER
ART UNIT 2817

B. Lee

May 16, 2003